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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,966	12/21/2001	Oskar J. Painter	CQC14NP	7507
36394	7590	04/27/2004	EXAMINER	
CHRISTIE, PARKER & HALE, LLP 350 W. COLORADO BLVD. SUITE 500 PASADENA, CA 91105				LEE, JOHN D
		ART UNIT		PAPER NUMBER
		2874		

DATE MAILED: 04/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/037,966	PAINTER ET AL.
	Examiner John D. Lee	Art Unit 2874

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 01 October 2003.  
 2a) This action is FINAL.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-139 is/are pending in the application.  
 4a) Of the above claim(s) 5-11,28-46 and 60-139 is/are withdrawn from consideration.  
 5) Claim(s) 12-22 is/are allowed.  
 6) Claim(s) 1-4,23-27 and 47-59 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) 1-139 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 21 December 2001 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**THE PREVIOUS HOLDING OF ABANDONMENT IS WITHDRAWN.**

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

A copy of the response to the previous Office action (paper number 6, mailed July 9, 2003) has been received. The response was originally submitted on October 1, 2003, and was delivered to the USPTO by the United States Postal Service at 9:39 AM on October 2, 2003. It is thus clear that there was a timely response to the previous Office action, and the recently mailed holding of Abandonment (paper number 0204, mailed February 5, 2004) was erroneous. No Abandonment of this application ever occurred. The holding of Abandonment is therefore withdrawn, and the following actions are now taken.

Claims 4 and 20 are objected to because of the following minor deficiencies. In claim 4, line 2, "form" should be "from"; and in claim 20, line 23, "for" should be inserted after "adapted".

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR § 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR § 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR § 3.73(b).

Claims 1-4, 23-27, and 47-59 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 83-112 of copending U.S. Patent Application Serial No. 10/187,030. Although the conflicting claims are not identical, they are not patentably distinct from each other

because all of the elements of the device set forth in the above-identified claims can be found in various combinations of claims 83-112 of copending U.S. Patent Application Serial No. 10/187,030. For example, claims 83, 112, and 91 of copending U.S. Patent Application Serial No. 10/187,030, taken together, represent the same invention as claim 1 of the present application. Slight differences, such as the last two lines of claim 23 of the present application, would be obvious to a person of ordinary skill in the art, since it would have been routine to position a multi-layer waveguide structure on a substrate, and since the various materials claimed are all well known and commonly used in the semiconductor arts. This is a *provisional* rejection because the claims have not, in fact, been patented.

Claims 12-22 are allowed. The transverse resonantly coupled optical devices of these claims are not disclosed or reasonably suggested by the prior art of record, particularly U.S. Patent 6,445,724 to Abeles (previously relied on).

Applicant's arguments filed on October 1, 2003, have been considered but are moot in view of the new grounds of rejection. The Examiner does, however, agree with applicant's characterization of the Abeles reference as set forth in the **REMARKS** of the 10/01/03 communication, and agrees that Abeles neither discloses nor suggests the invention as claimed herein. The previously applied rejections based upon Abeles are, therefore, withdrawn.

Any inquiry concerning the merits of this communication should be directed to Examiner John D. Lee at telephone number (571) 272-2351. The Examiner's normal work schedule is Tuesday through Friday, 6:30 AM to 5:00 PM. Any inquiry of a general or clerical nature (i.e. a request for a missing form or paper, etc.) should be

directed to the Technology Center 2800 receptionist at telephone number (571) 272-1562, to the technical support staff supervisor (Team 8) at telephone number (571) 272-1564, or to the Technology Center 2800 Customer Service Office at telephone number (571) 272-1626.

*John D. Lee*  
John D. Lee  
Primary Patent Examiner  
Group Art Unit 2874